

REMARKS

Claims 1-24 are pending in the current application. Claim 1 is in independent form. No new matter has been added. In view of the above amendments and following remarks, favorable reconsideration and allowance of the present application is respectfully requested.

Initially, Applicants appreciate the Examiner's acknowledgment that all certified copies pertaining to foreign priority claimed under 35 U.S.C. §119 have been received, acceptance of the formal drawings filed on March 16, 2006 and indication that the references submitted in the Information Disclosure Statements filed on March 16, 2006, June 12, 2006 and January 24, 2007 have been considered.

I. **CLAIM AMENDMENTS**

By the present Amendment, Applicants submit that independent claim 1 is amended. Applicants submit that support for amended independent claim 1 may be found, at least, on page 10 lines 27-29 of the Specification, as originally-filed. Thus, Applicants submit that the claim amendments do not introduce new matter.

II. **35 U.S.C. §112, FIRST PARAGRAPH REJECTION**

Claims 1-24 stand rejected under 35 U.S.C. §112, first paragraph, as based on a disclosure that is not enabling. Applicants respectfully traverse the rejection.

The rejection states that “[t]he specification indicates that the product of the instant invention is formic acid (see, for example, the examples), but the claims fail to recite the formation of formic acid.” Action, p. 2.

By the present Amendment, Applicants submit that independent claim 1 has been amended to recite a reducing process of carbon dioxide including “mixing carbon dioxide and water with an organometallic complex represented by general formula (1) so as to reduce carbon dioxide so that formic acid or alkali salt thereof is formed.” Thus, Applicants submit that the claims are now enabled by the disclosure.

As such, reconsideration and withdrawal of the rejection to independent claim 1 is respectfully requested.

II. CITED ART GROUNDS OF REJECTION

Claims 1-14, 23 and 24 stand rejected under 35 U.S.C. §102(b) as being anticipated by each of JP 2004-217632 or JP 2004-224715; and claims 15-22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over JP 2004-217632 or JP 2004-224715. Applicants submit that the rejections have been rendered moot in view of the following remarks.

Applicants note that JP 2004-217632 was published on August 5, 2004, and JP 2004-224715 was published on August 12, 2004. Applicants further note that the present U.S. Application is a national phase application of PCT/JP2004/013245 filed on September 10, 2004, therefore the filing date of the present application is also September 10, 2004.

Because JP 2004-217632 and JP 2004-224715 were published less than one year before the filing date of the present application (September 10, 2004), Applicants submit that JP 2004-217632 or JP 2004-224715 do not qualify as art under §102(b).

Furthermore, Applicants note that PCT/JP2004/013245 claims the benefit of priority from Japanese Patent Application No. 2003-324538, filed on September 17, 2003. By the present Amendment, Applicants enclose an English translation of Japanese Patent Application No. 2003-324538, along with a Statement of Accurate Translation signed by the translator, in order to “perfect” the claim of priority to Japanese Patent Application No. 2003-324538 made by the present U.S. application. Therefore, Applicants submit that the earliest date of invention currently established by the present application is September 17, 2003 (the filing date of Japanese Patent Application No. 2003-324538).

Thus, because the earliest date of invention established by the present application (September 17, 2003) precedes the publication date of JP 2004-217632 (August 5, 2004) and JP 2004-224715 (August 12, 2004), Applicants submit that JP 2004-217632 and JP 2004-224715 do not qualify as art under §102(a) or §102(e). Applicants note that JP 2004-217632 and JP 2004-224715 fail to qualify as art under §§102(c), (d), (f) or (g) for obvious reasons.

For at least these reasons, Applicants respectfully request that the Examiner reconsider and withdraw the §102(b) and §103(a) rejection to claims 1-24 over JP 2004-217632 and JP 2004-224715.

CONCLUSION

Accordingly, in view of the above, reconsideration of the rejections and allowance of each of claims 1-24 in connection with the present application is earnestly solicited.

Should there be any matters that need to be resolved in the present application; the Examiner is respectfully requested to contact the undersigned at the telephone number below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

HARNESS, DICKEY, & PIERCE, P.L.C.

By

 55,149

Donald J. Daley, Reg. No. 34,313

For

P.O. Box 8910
Reston, Virginia 20195
(703) 668-8000

DJD/CDW:psy

Enclosures:

English Translation of Japanese Patent Application No. 2003-324538
Verification of Translation